REMARKS/ARGUMENTS

Prior to the entry of this Amendment, claims 1, 2, 4, 6-11, 13, 20, 21, 23, 25-27 and 42-49 were pending in this application. Claims 48 and 49 have been amended, no claims have been canceled, and no claims have been added herein. Therefore, claims 1, 2, 4, 6-11, 13, 20, 21, 23, 25-27 and 42-49 remain pending in this application. Applicant respectfully requests reconsideration of these claims for at least the reasons presented below.

Claim Rejections Under 35 USC § 112

The Office Action has rejected claims 48 and 49 under 35 U.S.C. § 112, second paragraph. More specifically, claims 48 and 49 have been rejected as using a trademark/trade name as a claim limitation. The applicant respectfully submits that the objected to term, *i.e.*, Identity System, is not used to refer to any specific trademark or trade name. Rather, it is a term as defined in the specification used to refer to or identify a system used to manage identity information. See for example page 2, line 17 - page 3, line 3. However, for the sake of expediency and in an effort to move this matter toward allowance, the claims have been amended to replace to term "Identity System" with the term "identity system" to avoid the inference that this term refers to any specific trademark or trade name. By this amendment, the reasons for the rejection are thought to be overcome. Therefore, the applicant respectfully requests withdrawal of the rejection and allowance of the claims.

35 U.S.C. § 102 Rejection, Patterson

In the Office Action claims 1, 2, 4, 6, 8, 9, 11, 13, 20, 21, 23, 25-27, 42, 43, 45, 46, 48 and 49 have been rejected under 35 U.S.C.§ 102(e) as being anticipated by U. S. Patent Application Publication No. 2002/0053023 to Patterson et al. (hereinafter "Patterson"). The applicant respectfully traverses the rejection for at least the reasons presented below.

As an initial matter, the applicant respectfully submits that Patterson is not in fact prior art under 35 U.S.C.§ 102(e). More specifically, Patterson has a U.S. filing date of 2/28/01. It is noted that Patterson claims priority to a previously filed foreign application. However, with regard to determining the effective date of a reference as prior art under §102(e), MPEP §706.02(f)(1)(D) states:

> "Foreign applications' filing dates that are claimed (via 35 U.S.C. 119(a)-(d), (f), or 365(a) or (b)) in applications, which have been published as U.S. or WIPO application publications or patented in the U.S., may not be used as 35 U.S.C. 102(e) dates for prior art purposes. This includes international filing dates claimed as foreign priority dates under 35 U.S.C. 365(a) or (b)."

The applicant respectfully points out that Patterson was originally filed in Great Britain and later filed in the U.S. with a claim to the foreign application under 35 U.S.C. 119(a)-(d) or 365(b) as indicated in the declaration filed with that U.S. application on 2/28/01. Therefore, Patterson's effective date as prior art under §102(e) is the U.S. filing date of 2/28/01. Furthermore, the applicants respectfully point out that the present application claims priority to U.S. Provisional Application No. 60/258,087 filed on 12/22/00 which is earlier than Patterson's U.S. filing date of 2/28/01. Therefore, Patterson is not actually prior art under §102(e). For at least this reason, the rejection is improper and should be withdrawn.

However, assuming for the sake of argument that even if Patterson were considered prior art under 35 U.S.C.§ 102(e), the reference fails to anticipate the pending claims. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP 2131 citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Applicant respectfully argues that Patterson fails to disclose each and every claimed element. For example, Patterson fails to disclose, either expressly or inherently, determining whether to check a status for said certificate at a check time and, in response to determining to check the status for said certificate at a check time, determining whether to check the status for the certificate in real time.

As noted previously, Patterson "provides a certificate validation mechanism for a network interface." (page 1, para. 14) Under Patterson, "the certificate validation mechanism maintains a certificate cache that records certificates on which verification of validity has been performed along with an associated indication of validity resulting from the validity verification." (page 1, para. 14) More specifically, Patterson discloses receiving an email message and extracting a certificate from the received message. (page 3, para. 55) The received certificate is compared to certificates stored in a user cache. (page 3, para. 56) If the certificate is stored in the user cache, "validity information stored in the certificate in the user cache is extracted and associated with the received message." Page 3-4, para 57) If the received certificate is not stored in the user cache, a message is sent to a public repository to verify the certificate. The results of this verification are stored in the user cache. (page 4, para. 58-59) To maintain reliability of the user cache, certificates are purged from the cache based on the time since the certificate was last verified. However, Patterson does not disclose, expressly or inherently, determining whether to check a status for said certificate at a check time and, in response to determining to check the status for said certificate at a check time, determining whether to check the status for the certificate in real time. Rather, Patterson teaches a single determination, whether the received certificate is already in the user cache.

Independent claims 1 and 20, upon which all other pending depend, both recite in part "determining whether to check a status for said certificate at a check time; and in response to determining to check the status for said certificate at a check time, determining whether to check the status for the certificate in real time." However, Patterson does not disclose determining whether to check a status for said certificate at a check time and in response to determining to check the status for said certificate at a check time, determining whether to check the status for the certificate in real time. Rather Patterson teaches a single determination, whether the received certificate is already in the user cache. For at least these reasons, Applicant respectfully requests that the rejection be withdrawn and claims 1, 2, 4, 6, 8, 9, 11, 13, 20, 21, 23, and 25-27 be allowed.

Similarly, new claim 42, upon which new claims 43-49 depend, recites in part "determining whether to check a status for the certificate at a check time; in response to determining to not check the status for the certificate, exporting the certificate; [and] in response to determining to check the status for the certificate, determining whether to check the status for the certificate in real time." However, Patterson does not disclose determining whether to check a status for said certificate at a check time and in response to determining to check the status for said certificate at a check time, determining whether to check the status for the certificate in real time. Rather Patterson teaches a single determination, whether the received certificate is already in the user cache. For at least these reasons, Applicants respectfully request that claims 42-49 be allowed.

35 U.S.C. § 103 Rejection, Patterson in view of Wiener

The Office Action has rejected claims 7, 10, 26, 44 and 47 under 35 U.S.C. § 103(a) as being unpatentable over Patterson in view of U. S. Patent Application Publication No. 2003/0110376 to Wiener et al. (hereinafter "Wiener"). Applicant respectfully requests withdrawal of the rejection and allowance of the claims for at least the reason that claims 7, 10 26, 44 and 47 each depend upon independent claims that are thought to be allowable as discussed in detail above.

CONCLUSION

In view of the foregoing, Applicant believes all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.
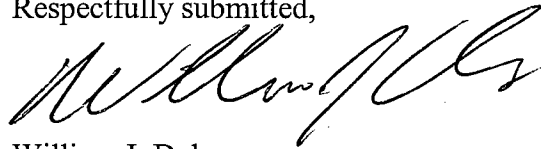
If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Dated: December 4, 2006   Respectfully submitted,

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